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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Sughrue Mion Zinn MacPeak & Seas PLLC
2100 Pennsylvania Avenue N W
Washington, DC 20037-3213

EXAMINER

POLLACK, MELVIN H

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 04/27/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

09/656,714

Applicant(s)

SATOU, MASA AKI

Examiner

Melvin H Pollack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached office action.

DETAILED ACTION

New Examiner

1. The instant application has been transferred to a new examiner. Please review the conclusion section for new contact information.

Response to Arguments

2. Applicant's arguments filed 20 February 2004 have been fully considered but they are not persuasive. An examination of the applicant's arguments are listed below.
3. The applicant alleges that Shobu does disclose notification to the terminal device via the D-channel, but not the D-channel packet exchange. That is, that the user does not fix notification at the packet rate, but allows for either rate.
4. The examiner rejects the applicant's reasoning. It first must be pointed out that the varying configurations are well known in the art and easily configurable without destroying Shobu. This is especially the case for events in which the notification message contains a lot of data and/or is in packet form, as Shobu would automatically use the lower rate. It is functionally equivalent to send a notification message through a broadband connection and a dialup connection, even if the size of the notification message would allow broadband to gain a wider efficiency. Likewise, unless Shobu expressly teaches away from ever using the "data packet" format, it would be obvious to at least one of ordinary skill in the art to at least allow the system to choose based on some factor, be it the size of the message or a programmer's decision. That is, even if the applicant was right, it would still be obvious to one of ordinary skill in the art, at the time the invention was made, to fix the D-channel based on the size of the messages being

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sent, in order to gain an efficiency on the service (col. 4, lines 48-50), and the examiner would still consider the claims unpatentable as currently drawn.

5. Having said all this, it is clear that Shobu does expressly disclose the use of the D-channel to send notifications in packets or frames (col. 5, lines 2-6). Thus, Shobu does in fact show notifications using a D-channel packet exchange. Therefore, the claims remain rejected.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "using a D-channel for low speed data packet exchange) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims as currently drawn are fixed solely on providing notification and signaling messages. Furthermore, the lack of clarity in the claims regarding the size or contents of the notification messages et al. indicates that the ability to handle larger packets isn't per se necessary. The applicant should consider clarifying the notification message or the D-channel usage.

7. The applicant also claims that Corrigan does not adequately disclose "necessary data transmission times." The examiner disagrees. While Corrigan does concentrate on TDMA, it is the setup and use of time-division multiplexing that fulfills this limitation, especially regarding the assignment of messages to time slots (col. 2, lines 55-65). None of the claims specify a particular mechanism to determine necessary transmission times, but state the purpose is to determine whether a user is allowed to transmit or not. This is the purpose of TDMA, which allows people to transmit only at select times, such issues arbitrated through notification messages (col. 7, lines 29-60). Therefore, the examiner also rejects this line of reasoning.

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8. For the reasons above, and for the reasons in the original rejection, the rejection stands. Therefore, this case is final.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 7 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 5,692,130 to Shobu et al.

11. As per claim 1, Shobu et al teaches a server-client type system in which a terminal device on a client side is connected to a server through an ISDN network and corresponding one or at least two digital service units, wherein said server comprises notification means for notifying, when a large volume of data to be transmitted whose volume is not less than a predetermined value is generated, to said terminal device as a transmission destination to the effect that the large volume of data is to be transmitted by the D-channel packet exchange (See col. 3, lines 43-55 and col. 4, lines 42-64); and transmission means for, after the reception of a data transmission timing signal from said terminal device, starting transmission of said large volume of data using a B-channel to cause the terminal device to download the large volume of data, and it said terminal device comprises(See col. 6. lines 15-41);monitoring means for monitoring a state of a free B-channel line of all ISDN communication devices on the client side connected to said digital service unit to which the terminal device in question is connected upon receiving said notification of transmission of the large volume of data from said server (See col. 5, lines 58-67);

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and transmission allowance notifying means for notifying said server of said data transmission timing signal by the D-channel packet exchange at timing not preventing use of a B-channel line with the help of said monitoring means (See col. 6, lines 1-4)

12. As per claim 7, Shobu et al teaches the method of notifying; when a large volume of data to be transmitted whose volume is not less than a predetermined value is generated, to said terminal device as a transmission destination to the effect that the large volume of data is to be transmitted by the D-channel packet exchange (See col. 3, lines 43-55 and col. 4, lines 42-64), the step, by said terminal device receiving said notification of transmission of they large volume of data, of monitoring a state of a free B-channel line of all ISDN communication devices connected-to said digital service unit to which the terminal device in question is connected, and notifying said server of a data transmission timing signal by the D-channel packet exchange at timing not preventing use of a B-channel line (See col. 5, lines 58-67 and coo. 6, lines 15-41), and the step, by said server, of, after receiving the data transmission timing signal, starting transmission of said large volume of data using the B-channel to cause said terminal device to download the-large volume of data (See col. 6, lines 1-4).

13. As per claim 12, Shobu et al teaches a data downloading method in a server-client type system for transmitting data generated at a server to a terminal device on an arbitrary client side for downloading through an ISDN network and a digital service unit, comprising the steps of the step, by said server, of notifying, when a large volume of data to be transmitted whose volume is not less than a predetermined value is generated, to said terminal device as a transmission destination to the effect that the large volume off data is to be transmitted together with a data transmission time by the D-channel packet exchange (See col. 3, lines 43-55 and col. 4, lines 42-

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64, the step by said terminal device receiving the notification, of announcing said data transmission time to authorize a user to determine allowance/non-allowance of transmission and notifying said transmission allowance signal by the D-channel packet exchange through operation of said user based on the announcement (See col. 3, lines 61-67), and the step, by said server, of, after receiving the data transmission allowance signal, starting the transmission of said large volume of data using the B-channel to cause said terminal device to download the large volume of data (See col. 6, lines 1-4).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,692,130 to Shobu et al in view of U.S. Patent No. 5,594,867 to Yoshida.

16. As per claims 2 and 8, Shobu et al teaches the claimed invention as described above. However, Shobu et al fails to teach wherein said terminal device comprises time zone determination means for determining, whether the reception time is within a use-allowed time zone or not.

17. Yoshida teaches a data communication apparatus which transmits in accordance with a reception time zone or a terminal from which data has been received. Furthermore, Yoshida teaches wherein said terminal device comprises time zone determination means for determining, whether the reception time is within a use-allowed time zone or not (See abstract, lines 11-12).

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18. It would have been obvious to one with ordinary skill in the art at the time of the invention was made to incorporate said terminal device comprises time zone determination means for determining, whether the reception time is within a use-allowed time zone or not. Yoshida in the claimed invention of Shobu et al in order to determine whether a communication to be executed satisfies the predetermined condition (See abstract, lines 5-6).

19. As per claim 3 and 9, Shobu et al teaches the claimed invention as described above. Furthermore, Shobu et al teaches wherein said terminal device if the time when said notification of transmission of the large volume of data is received from said sever is upon a lapse of a first predetermined time with, the B-channels of all the ISDN communication devices connected to said digital service unit to which the terminal device in question is connected being all free, notifies said server of a transmission allowance to cause the server to transmit said large volume of data, and if the time when said notification of transmission of the large volume of data is received from said server is not within said B-channel use allowed time zone and at that time, apart of the B channels of all the ISDN communication devices connected to said digital service unit to which the terminal device in question is connected are free, notifies said server of a transmission non-allowance to cause the server receiving the transmission non-allowance to again notify said terminal device to the effect that said large volume of data is to be transmitted by the D-channel packet exchange upon a lapse of a second predetermined time. However, Shobu et al does not teach a use-allowed time zone.

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20. Yoshida teaches a data communication apparatus which transmits in accordance with a reception time zone or a terminal from which data has been received. Furthermore, Yoshida teaches a use-allowed time zone (See abstract, lines 11-12)

21. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the a use-allowed time zone as taught by Yoshida in the claimed invention of Shobu et al in order to determine whether a communication to be executed satisfies the predetermined condition (See abstract, lines 5-6).

22. Claims 4, 5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 5,692,130 to Shobu et al in view of U.S. Patent No. 5,594,867 to Yoshida as applied to claim 3 above, and further in view of U.S. Patent No. 5,909,673 to Gregory.

23. As per claims 4 and 10, Shobu et al in view of Yoshida teaches the claimed invention as described above. However, Shobu et al in view of Yoshida fails to teach wherein the terminal device conducts calling to said server for downloading instead of said transmission allowance notification.

24. Gregory teaches wherein a terminal device conducts calling to said server for downloading instead of said transmission allowance notification (See abstract, lines 17-19).

25. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein a terminal device conducts calling to said server for downloading instead of said transmission allowance notification as taught by Gregory in the claimed invention of Shobu et al in view of Yoshida in order to for the terminal device to download the proper elements from the centralized server (See col. 3, lines 59-63).

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26. As per claims 5 and 11, Shobu et al teaches the claimed invention as described above. Furthermore, Shobu et al teaches there is at least one free B-channel line among all the ISDN communication devices connected to said digital service unit to which the terminal device in question is connected when the terminal device receives said notification of transmission of the large volume of data from said server (See col. 36, lines 56- 67). However, Shobu et al fails to teach wherein said terminal device conducts calling to said server for downloading.

27. Gregory teaches wherein a terminal device conducts calling to said server for downloading (See abstract, lines 17-19).

28. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein a terminal device conducts calling to said server for downloading as taught by Gregory in the claimed invention of Shobu et al in order for the terminal device to download the proper elements from the centralized server (See col. 3, lines 59-63).

29. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No 5,692,130 to Shobu et al in view of U.S. Patent No. 5, 966,636 to Corrigan et al.

30. As per claim 6, Shobu et al teaches a server-client type system in which at least one terminal device on a client side is connected to a server through an ISDN network and corresponding one or at least two digital service units, wherein said server comprises: notification means for notifying, when a large volume of data to be transmitted whose volume is not less than a predetermined value is generated, to said terminal device as a transmission destination to the effect that the large volume of data is to be transmitted by the D-channel

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packet exchange (See col. 3, lines 43-55 and col. 4, lines 42-64);, and transmission means for, after the reception of a data transmission allowance signal from said terminal device starting transmission of said large volume of data using a B-channel to cause the terminal device to download the large volume of data, and said terminal device comprises: announcement means for upon receiving said notification of transmission of the large volume of data with the data transmission time applied from said server, announcing said data transmission time to authorize a user to determine allowance/non-allowance of transmission; and transmission allowance notifying means for notifying said transmission allowance signal by the D-channel packet exchange through operation of said user based on the announcement of said announcement means (See col. 3, lines 43-55,col. 4, lines 42-64, col. 5, lines 58-67 , col. 6, lines 15-41 and See col. 6, lines 1-4). However, Shobu et al fails to teach a necessary data transmission time

31. Corrigan et al teaches a method and apparatus for multiple access over randomized slots with collision detection in a cable telephony system. Furthermore, Corrigan et al teaches a necessary data transmission time (See col. 1, lines 11-30).

32. It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a necessary data transmission time as taught by Corrigan et al in the claimed invention of Shobu et al in order to provide more channels and to increase the number of users that may operate on the system (See col. 1, lines 19-21).

Conclusion

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (703) 305-4641. The examiner can normally be reached on 8:30-5:00 M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP
21 April 2004


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER